

## REMARKS

Claims 10-11 and 13-14 are currently pending in the application. Claims 13 and 14 have been amended to address the Examiner's rejection under 35 U.S.C. § 112.

On page 3 of the Office Action, the Examiner again rejected claims 10-11 under 35 U.S.C. § 101 due to the claimed invention allegedly being directed to non-statutory subject matter.

According to the Examiner, the claims allegedly can be implemented without computer or machine, that is, by a human with a pencil and a piece of paper. The Examiner asserts that the invention requires use of hardware to accomplish its operation and "technological arts" should be implemented or performed by a computer or machine.

As the undersigned explained in a conversation with the Examiner's supervisor, the Examiner appears to have inappropriately ignored the Board's ruling in Ex parte Lundgren. As explained in Applicants' response dated December 15, 2005, in Ex parte Lundgren, the Board ruled that there is currently no judicially recognized 'technological arts' test to determine patent eligible subject matter under 35 U.S.C. § 101. In light of the foregoing, the Examiner's rejection is clearly in direct contradiction to established law, as reflected in Ex parte Lundgren. Withdrawal of the rejection is, therefore, requested.

On page 3 of the Office Action, the Examiner stated that the language of claims 10-11 raise a question as to whether the claimed method is directed merely to an abstract idea that is not tied to producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. § 101.

In the present invention, a digital document discussion method is provided. In particular, a discussion requester creates a document to be discussed using document templates. The discussion document is then sent to a discussion participant along with a discussion request to allow discussion of the document by the participant. The participant then transmits a discussion reply. See Figure 22. In at least one embodiment, "material information" associated with the discussion document can be searched and provided to the discussion participant. See specification of the present invention, page 21, lines 8-12. See also specification of the present invention, page 11, line 24 – page 12, line 1. "Material information" is information on a material

closely associated with the object (e.g., document) and referred to when the object is discussed. See specification of the present invention, page 36, lines 11-14.

As material information designated by the discussion participant is searched from a plurality of items of material information associated with the requested object by the search server and provided to the discussion participant when the object is discussed, it is possible to save labor for searching a material necessary for the discussion and to discuss the object more promptly. See specification of the present invention, page 42, line 25 – page 43, line 7.

In State Street & Trust Company v. Signature Financial Group, Inc., 1998 U.S. App. LEXIS 16869, the Court held:

( . . . ) the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces “a useful, concrete and tangible result -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

Applicants respectfully submit that the present invention clearly produces “a useful, concrete, and tangible result.” For example, the method of the present invention produces “material information,” which is provided to the discussion participants, and is clearly “a useful, concrete and tangible result” in that it is tangible information that saves labor for searching for material information necessary for discussion of the discussion document. In addition, the present invention produces a “useful, concrete, and tangible result” in that it provides a document with associated comments, thereby enabling a requestor to obtain comments regarding a document for discussion.

In light of the foregoing, Applicants respectfully submit that the present invention, as defined by the pending claims, is patentable under 35 U.S.C. § 101, as it clearly produces a “useful, concrete, and tangible result.” Withdrawal of the rejection is respectfully requested.

On page 5 of the Office Action, claims 13-14 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

In particular, the Examiner alleged that there is insufficient antecedent basis for the phrase, "the discussion document based on" in line 12 of claim 13. The Examiner alleged that there is insufficient antecedent basis for the phrase "the discussion document based on" in line 11 of claim 14. Applicants have amended claims 13 and 14 to address the rejection. Therefore, withdrawal of the rejection is respectfully requested.

Finally, the Examiner rejected claims 13 and 14 due to the phrase "allowing the computer to function" in line 3 of the claims. In particular, according to the Examiner, the term "allowing" fails to particularly point out and distinctly claim the invention because it is allegedly unclear what Applicants' intended metes and bounds of the claim are. The Examiner alleged that, "the claims appear to cover anything and everything that does not prohibit action from occurring."

Applicants have amended claims 13 and 14 to address the rejection. Therefore, withdrawal of the rejection is respectfully requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

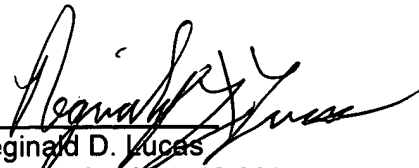
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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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